

REMARKS

This communication is in response to the Nonfinal Office Action dated December 26, 2008, in which claims 1-15, 25-54, 78-88, 93-105, and 111-121 were rejected under 35 U.S.C. 101, claims 1-15, 25-54, 78-88, 93-105, and 111-121 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, claims 1-15, 25-54, 78-88, 93-105, and 111-121 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement, claims 1-15, 25-35, 42, 43, 49-54, 78-81, 83, 86-88, 93-96, 98, 101-105, 111-116, and 119 were rejected under 35 U.S.C. 112, second paragraph, claims 36-41, 44-48, 82, 84, 85, 97, 99, 100, 117, 118, 120, and 121 were rejected under 35 U.S.C. 112, second paragraph, claims 1, 11-14, 25, 34-36, 42, 44-47, 78, 81-85, 93, 96-100, 111, 115-117, and 119-121 were rejected under 35 U.S.C. 103(a) as being unpatentable over Huang et al. (US 7,149,917) in view of Heinrich (US 20050114186), claims 2-10, 15, 26-33, 37-41, 43, 48, 49-54, 79, 80, 86-88, 94, 95, 101-105, 112-114, and 118 were rejected under 35 U.S.C. 103(a) as being unpatentable over Huang and Heinrich as applied above, and further in view of official notice.

Rejection of claims 1-15, 25-54, 78-88, 93-105, and 111-121 under 35 U.S.C. 101

The Office Action stated “Claims 1-15, 25-54, 78-88, 93-105, and 111-121 were rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.”

Per claims 1-15, 25-54 and 78-85

The Office Action stated "The Examiner suggests a "computer-readable medium having tangibly stored thereon computer-executable instructions causing a computer to perform a method comprising," or some similar Beauregard-style claim."

In response, claims 1-15, 25-54 and 78-85 are amended herein in accordance with the suggestion per claim 55 on page 3 of the Office Action to Beauregard format: "A computer-readable medium having tangibly stored thereon computer-executable instructions causing a computer to perform a method comprising." The amendments are supported by paragraphs 23-22 and 76-80 of the specification. Applicant requests withdrawal of the rejection of claims 1-15, 25-54 and 78-85 under 35 U.S.C. 101.

Per claims 86-88, 93-105, and 111-121

The Office Action stated: "As to claims 86-88, 93-105, and 111-121, a system or apparatus is claimed, but no physical structure defining the system or apparatus is recited. The various "generators" and "collectors" are software, not hardware. Applicant is advised to add physical structure, such as processors, storage devices, etc."

In response claims 86-88, 93-105 and 111-121 are amended herein to require "a processor operably coupled to a computer-readable medium, the computer-readable medium having tangibly stored thereon." The amendments are supported by paragraphs 23-22 and 76-80 of the specification. Applicant requests withdrawal of the rejection of claims 86-88, 93-105 and 111-121 under 35 U.S.C. 101.

Rejection of claims 1-15, 25-54, 78-88, 93-105, and 111-121 under 35

U.S.C. 112, first paragraph written description

The Office Action stated “Claims 1-15, 25-54, 78-88, 93-105, and 111-121 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.”

Per claims 1-15, 25-35, 42, 43, 49-54, 78-81, 83, 86-88, 93-96, 98, 101-105, and 111-116, and 119

The Office Action stated:

“Correlation has special meaning to a person of ordinary skill in the art. Correlation refers to a statistical calculation indicating the strength and direction of a linear relationship between two random variables. Applicant's specification does not specifically re-define the term from its ordinary meaning. However, Applicant does not use correlation according to its accepted meaning, and provides no written description as to what Applicant's version of correlation is. Applicant "correlates" data between more than two random variables (e.g. claim 8), which cannot happen using the ordinary meaning of correlation. One of ordinary skill in the art would necessarily require a written description discussing what Applicant's new way to "correlate" data is, in order to apprise the person of ordinary skill what Applicant considers his invention.”

Applicant re-defined the well-known term "correlating" without providing a description as to how one of ordinary skill in the art would make and/or use the invention with this undisclosed form of "correlating." It would be impossible to guess what Applicant's actual methods are because the specification provides no guidance. No examples are

given.”

Paragraph 45 of the specification states “In the correlating 306, associations for individual resources between the infrastructure performance data and the process data are determined.” The particular implementation of “correlating” described in paragraph 45 is not a “redefinition” of “correlating.” On the contrary, the particular implementation of “correlating” described in paragraph 45 is merely a particular embodiment that is described in the manner used in some implementations that is consistent and not repugnant with the plain meaning of “correlating” [MPEP 2111.01(I)].

Per claims 36-41, 44-48, 82, 84, 85, 97, 99, 100, 117, 118, 120, and

121

The Office Action stated:

“In claims 36-41, 44-48, 82, 84, 85, 97, 99, 100, 117, 118, 120, and 121, the claims recite the generation of a risk profile without "correlation" of the data. There is no written description of such an embodiment in the specification. All embodiments are disclosed to require "correlation" before "generation" of the risk. One of ordinary skill in the art would not be apprised of an invention not requiring something the written description specifically requires.”

Applicant notes that paragraph 73 of the specification states “In some embodiments, risk profile generator 736 generates a risk profile from the correlated data 308 in FIG. 3” which provides a distinct and clear indication that in some embodiments, risk profile generator 736 generates a risk profile from a source other than the correlated data 308 in FIG. 3

that does not require correlation before generation of the risk.

Nonetheless, Applicant herein amends claims 36 and 82 to require “correlating the infrastructure data and the process data” and claim 97 is amended here to require “a correlator of the infrastructure performance data and the process data” and claim 117 is amended herein to require “apparatus operable to correlate the infrastructure data and the process data.” Therefore, Applicant requests withdrawal of the rejection of claims 36-48, 82-85, 97-100 and 117-121 under 35 U.S.C. 112, first paragraph written description requirement.

Rejection of claims 1-15, 25-54, 78-88, 93-105, and 111-121 under 35 U.S.C. 112, first paragraph enablement clause

The Office Action stated “Claims 1-15, 25-54, 78-88, 93-105, and 111-121 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.”

Per claims 1-15, 25-35, 42, 43, 49-54, 78-81, 83, 86-88, 93-96, 98, 101-105, 111-116, and 119

The Office Action stated: “Applicant re-defined the well-known term “correlating” without providing a description as to how one of ordinary skill in the art would make and/or use the invention with this undisclosed form of “correlating.” It would be impossible to guess what Applicant's actual methods are because the specification provides no guidance. No examples are given.”

Paragraph 45 of the specification states: “In the correlating 306, associations for individual resources between the infrastructure performance data and the process data are determined” and “The

correlating 306 allows data from the infrastructure performance data and the process data for a resource to be aggregated, thus providing a more thorough, heterogeneous and diverse analysis of a resource.” Paragraph 46 of the specification also states:

“Correlating 306 in one embodiment is performed in reference to common data object. In each information technology system, a particular resource is identified by a common name in the common data object. In correlating 306, data associated with the common name of each information technology resource is aggregated between various data sources of the infrastructure performance data and the process data.”

The particular implementations of “correlating” described in paragraphs 45 and 46 provide detail that is far beyond a disclosure of a bare-bones mere “correlation” that is sufficient to make and/or use the invention. Therefore, Applicant requests withdrawal of the rejection of claims 1-15, 25-35, 42, 43, 49-54, 78-81, 83, 86-88, 93-96, 98, 101-105, 111-116, and 119 under 35 U.S.C. 112, first paragraph, enablement requirement.

Rejection of claims 1-15, 25-35, 42, 43, 49-54, 78-81, 83, 86-88, 93-96, 98, 101-105, 111-116, and 119 under 35 U.S.C. 112, second paragraph

The Office Action stated “Claims 1-15, 25-35, 42, 43, 49-54, 78-81, 83, 86-88, 93-96, 98, 101-105, 111-116, and 119 were rejected under 35 U.S.C. 112, second paragraph.”

Per claims 1-15, 25-35, 42, 43, 49-54, 78-81, 83, 86-88, 93-96, 98, 101-105, and 111-116, and 119

The Office Action stated:

“Correlation has special meaning to a person of ordinary skill in the art. Correlation refers to a statistical calculation indicating the strength and direction of a linear relationship between two random variables. Applicant's specification does not specifically re-define the term from its ordinary meaning. However, Applicant does not use correlation according to its accepted meaning, and provides no written description as to what Applicant's version of correlation is. Applicant "correlates" data between more than two random variables (e.g. claim 8), which cannot happen using the ordinary meaning of correlation. One of ordinary skill in the art would necessarily require a written description discussing what Applicant's new way to "correlate" data is, in order to apprise the person of ordinary skill what Applicant considers his invention.”

Applicant re-defined the well-known term "correlating" without providing a description as to how one of ordinary skill in the art would make and/or use the invention with this undisclosed form of "correlating." It would be impossible to guess what Applicant's actual methods are because the specification provides no guidance. No examples are given.”

Paragraph 45 of the specification states “In the correlating 306, associations for individual resources between the infrastructure performance data and the process data are determined.” The particular implementation of “correlating” described in paragraph 45 is not a “redefinition” of “correlating.” On the contrary, the particular implementation of “correlating” described in paragraph 45 is merely a particular embodiment that is described in the manner used in some

implementations that is consistent and not repugnant with the plain meaning of “correlating” [MPEP 2111.01(I)].

Claims 36-41, 44-48, 82, 84, 85, 97, 99, 100, 117, 118, 120, and 121 under 35 U.S.C. 112, second paragraph

The Office Action stated “Claims 36-41, 44-48, 82, 84, 85, 97, 99, 100, 117, 118, 120, and 121 were rejected under 35 U.S.C. 112, second paragraph” and “The omitted elements are the ‘correlating’ element/step.”

In response, claims 36, 82 and 97 are amended herein to require “correlating” and claim 117 is amended herein to include “correlate.” Applicant requests withdrawal of the rejection of 36-41, 44-48, 82, 84, 85, 97, 99, 100, 117, 118, 120, and 121 were rejected under 35 U.S.C. 112, second paragraph.

Rejection of claims 1, 11-14, 25, 34-36, 42, 44-47, 78, 81-85, 93, 96-100, 111, 115-117, and 119-121 under 35 U.S.C. 103(a)

The Office Action stated “[c]laims 1, 11-14, 25, 34-36, 42, 44-47, 78, 81 -85, 93, 96-100, 111, 115-117, and 119-121 were rejected under 35 U.S.C. 103(a) as being unpatentable over Huang et al. (US 7,149,917) in view of Heinrich (US 20050114186).”

Per claims 1, 25, 49, 78

Claim Amendments: Claims 25, 49 and 78 are amended herein to require “in which associations for individual resources between the infrastructure performance data and the process data are determined in reference to common data object, in which a particular resource is identified by a common name in the common data object, in which data

associated with the common name of each information technology resource is aggregated between various data sources of the infrastructure performance data and the process data” and claim 1 is amended herein to require “the correlating including determining associations for individual resources between the infrastructure performance data and the process data, the determining in reference to a common data object, the determining including identifying a particular resource by a common name in the common data object, wherein data associated with the common name of each information technology resource is aggregated between various data sources of the infrastructure performance data and the process data.” The added matter of those claims is not disclosed by the references of record. In particular, the added matter of those claims are not disclosed by col. 3 lines 26-30 of Huang. Thus, Applicant requests withdrawal of the rejections of claims 1, 25, 49 and 78 and the dependent claims 2-15, 26-35, 49-54 and 79-81, respectively under 35 U.S.C. 103(a).

“Correlating” The Office Action cites col. 3 lines 26-30 of Huang as disclosure of “correlating the infrastructure performance data and the process data”

An outage monitoring manager 40 in the OMS 15 locally monitors for these different failures and stores outage data 42 associated by with that outage monitoring and measurement. The outage data 42 can be accessed the NMS 12 or other tools for further correlation and calculation operations. (Huang col. 3 lines 26-30)

However, Huang col. 3 lines 26-30 does not disclose what data is correlated to which data. In particular, Huang col. 3 lines 26-30 does not

disclose “correlating the infrastructure performance data and the process data” as claims 1, 25, 49 and 78 require. Thus, Applicant requests withdrawal of the rejections of claims 1, 25, 49 and 78 and the dependent claims 2-15, 26-35, 49-54 and 79-81, respectively under 35 U.S.C. 103(a).

Per claims 12, 45, 53, 85, 88, 104 and 121

The Office Action cites “claim 1 step d” of Huang as disclosure of “each measurement being multiplied by a weighting value associated with each measurement.”

Claim 1 step d of Huang recites “polling for layer-2 outages using the outage measurement systems and polling for layer-3 outages according to results of the layer-2 polling” which does not disclose any “weighting” or multiplication”, much less “each measurement being multiplied by a weighting value associated with each measurement” as claims 12, 45, 53, 85, 88, 104 and 121 require. Thus, Applicant requests withdrawal of the rejections of claims 12, 45, 53, 85, 88, 104 and 121 under 35 U.S.C. 103(a).

Per claims 36 and 82

The Office Action cites col. 3 lines 26-30 of Huang as disclosure of “correlating the infrastructure performance data and the process data”

However, Huang col. 3 lines 26-30 does not disclose what data is correlated to which data. In particular, Huang col. 3 lines 26-30 does not disclose “correlating the infrastructure performance data and the process data” as claims 36 and 82 require. Thus, Applicant requests withdrawal of the rejections of claims 36 and 82 and the dependent claims 37-48 and 83-85, respectively under 35 U.S.C. 103(a).

Per claim 93

The Office Action cites col. 3 lines 26-30 of Huang as disclosure of “correlating the infrastructure performance data and the process data”

However, Huang col. 3 lines 26-30 does not disclose what data is correlated to which data. In particular, Huang col. 3 lines 26-30 does not disclose “a correlator of the infrastructure performance data and the process data” as claim 93 requires. Thus, Applicant requests withdrawal of the rejections of claims 93 and the dependent claims 94-96 under 35 U.S.C. 103(a).

Per claim 97

The Office Action cites col. 3 lines 26-30 of Huang as disclosure of “correlating the infrastructure performance data and the process data”

However, Huang col. 3 lines 26-30 does not disclose what data is correlated to which data. In particular, Huang col. 3 lines 26-30 does not disclose “a correlator of the infrastructure data and the process data” as claim 97 requires. Thus, Applicant requests withdrawal of the rejections of claims 97 and the dependent claims 99-100 under 35 U.S.C. 103(a).

Per claim 111

The Office Action cites col. 3 lines 26-30 of Huang as disclosure of “correlating the infrastructure performance data and the process data”

However, Huang col. 3 lines 26-30 does not disclose what data is correlated to which data. In particular, Huang col. 3 lines 26-30 does not disclose “apparatus operable to correlate the infrastructure performance data and the process data” as claim 111 requires. Thus, Applicant requests withdrawal of the rejections of claims 111 and the dependent claims 112-

116 under 35 U.S.C. 103(a).

Per claim 117

The Office Action cites col. 3 lines 26-30 of Huang as disclosure of “correlating the infrastructure performance data and the process data”

However, Huang col. 3 lines 26-30 does not disclose what data is correlated to which data. In particular, Huang col. 3 lines 26-30 does not disclose “apparatus operable to correlate the infrastructure data and the process data” as claim 117 requires. Thus, Applicant requests withdrawal of the rejections of claims 117 and the dependent claims 118 and 120-121 under 35 U.S.C. 103(a).

Prima Facie Obviousness

KSR International Co. v. Teleflex Inc. (KSR) requires that a rejection based on obviousness must make “explicit” a detailed explanation of “the effects of demands known to the design community or present in the marketplace” and “the background knowledge possessed by a person having ordinary skill in the art.” (KSR Opinion at p. 14). Anything less than such an explicit analysis is not sufficient to support a prima facie case of obviousness.

Based upon KSR International Co. v. Teleflex Inc. the Office Action does not show any sufficient reason in obviousness for combining the references, and therefore the claims are not obvious in view of any combination of the cited references.

To establish a prima facie case of obviousness, the Supreme Court has articulated a four-prong test for determining obviousness:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

See *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. ____ (2007), citing *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966).

The rejections of claims 1, 11-14, 25, 34-36, 42, 44-47, 78, 81-85, 93, 96-100, 111, 115-117, and 119-121 under 35 U.S.C. 103(a) do not discuss or “[r]esolve the level of ordinary skill in the pertinent art.” As a result, a prima facie case of obviousness of claims 1, 11-14, 25, 34-36, 42, 44-47, 78, 81-85, 93, 96-100, 111, 115-117, and 119-121 under 35 U.S.C. 103(a) was not presented in the Office Action. Applicant requests that the rejections of claims 1, 11-14, 25, 34-36, 42, 44-47, 78, 81-85, 93, 96-100, 111, 115-117, and 119-121 under 35 U.S.C. 103(a) be withdrawn.

Rejection of claims 2-10, 15, 26-33, 37-41, 43, 48, 49-54, 79, 80, 86-88, 94, 95, 101-105, 112-114, and 118 35 U.S.C. 103(a)

Claim Amendments: Claims 49, 86, 101, 111 and 117 are amended herein to require “in which associations for individual resources between the infrastructure performance data and the process data are determined in reference to common data object, in which a particular resource is identified by a common name in the common data object, in which data associated with the common name of each information technology resource is aggregated between various data sources of the infrastructure

performance data and the process data.” The added matter of those claims is not disclosed by the references of record. In particular, the added matter of those claims are not disclosed by col. 3 lines 26-30 of Huang. Thus, Applicant requests withdrawal of the rejections of claims 49, 86, 101, 111 and 117 and the dependent claims 50-54, 87-8, 102-105, 112-116 and 118-121, respectively under 35 U.S.C. 103(a).

Official Notice: The Office Action stated “[c]laims 2-10, 15, 26-33, 37-41, 43, 48, 49-54, 79, 80, 86-88, 94, 95, 101-105, 112-114, and 118 were rejected under 35 U.S.C. 103(a) as being unpatentable over Huang and Heinrich as applied above, and further in view of official notice.” Applicant respectfully traverses this official notice and requests a reference that describes such an element. Absent a reference, it appears that personal knowledge is used, therefore, the Applicant respectfully requests an affidavit of the Examiner pertaining to the personal knowledge as required by 37 C.F.R. § 1.104(d)(2).

Per claim 2: The Office Action took official notice “that it is old and well known in the art to collect data concurrently with other data.” Claim 2 is more specific than the mere requirement of “to collect data concurrently with other data.” Applicant respectfully traverses this Official Notice and requests a reference that describes such the elements of Office Notice. Absent a reference, it appears that personal knowledge is used, therefore, the Applicant respectfully requests an affidavit of the Examiner pertaining to the personal knowledge as required by 37 C.F.R. § 1.104(d)(2).

Per claims 3-7: The Office Action took official notice “that it is old and well known to collect data using data collection tools.” Claims 3-7 are more specific than the mere requirement “to collect data using data collection tools.” Applicant respectfully traverses this official notice and requests a reference that describes such an element. Absent a reference, it appears that personal knowledge is used, therefore, the Applicant respectfully requests an affidavit of the Examiner pertaining to the personal knowledge as required by 37 C.F.R. § 1.104(d)(2).

Per claims 8-10 and 113: The Office Action took official notice “that it is old and well known to use relevant data in analysis.” Claims 8-10 and 113 are more specific than the mere requirement “to use relevant data in analysis.” Applicant respectfully traverses this official notice and requests a reference that describes such an element. Absent a reference, it appears that personal knowledge is used, therefore, the Applicant respectfully requests an affidavit of the Examiner pertaining to the personal knowledge as required by 37 C.F.R. § 1.104(d)(2).

Per claim 15: The Office Action took official notice “that it is old and well known that outages are not good.” The Official Notice is irrelevant to the requirements of claim 15. Applicant respectfully traverses this official notice and requests a reference that describes such an element. Absent a reference, it appears that personal knowledge is used, therefore, the Applicant respectfully requests an affidavit of the Examiner pertaining to the personal knowledge as required by 37 C.F.R. § 1.104(d)(2).

Per claim 26: The Office Action took official notice “that it is old and

well known to collect one set of data before the other.” Claim 26 is more specific than the mere requirement of “to collect one set of data before the other.” Applicant respectfully traverses this official notice and requests a reference that describes such an element. Absent a reference, it appears that personal knowledge is used, therefore, the Applicant respectfully requests an affidavit of the Examiner pertaining to the personal knowledge as required by 37 C.F.R. § 1.104(d)(2).

Per claim 86

The Office Action cites col. 3 lines 26-30 of Huang as disclosure of “correlating the infrastructure performance data and the process data”

However, Huang col. 3 lines 26-30 does not disclose what data is correlated to which data. In particular, Huang col. 3 lines 26-30 does not disclose “a correlator of the infrastructure performance data and the process data” as claim 86 requires. Thus, Applicant requests withdrawal of the rejections of claims 86 and the dependent claims 87-88 under 35 U.S.C. 103(a).

Per claim 101

The Office Action cites col. 3 lines 26-30 of Huang as disclosure of “correlating the infrastructure performance data and the process data”

However, Huang col. 3 lines 26-30 does not disclose what data is correlated to which data. In particular, Huang col. 3 lines 26-30 does not disclose “apparatus operable to correlate the infrastructure performance data and the process data” as claim 101 requires. Thus, Applicant requests withdrawal of the rejections of claims 101 and the dependent claims 102-105 under 35 U.S.C. 103(a).

Conclusion

Applicant believes that claims 1-15, 25-54, 78-88, 93-105 and 111-121 are allowable. If any issues remain that prevent issuance of this application, the Examiner is urged to contact the undersigned attorney Michael G. Smith at 202-595-1444 x2.

Respectfully Submitted,



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